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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,434	03/09/2000	Feng-Nien Ko	11544-003001	3204

26161 7590 05/06/2003

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

FILE COPY

Office Action Summary

Application No.	Applicant(s)	
09/522,434	KO ET AL.	
Examiner	Art Unit	
Susan Coe	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-9 and 11-37 is/are pending in the application.
- 4a) Of the above claim(s) 3-5,7-9 and 12-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 21.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 4, 2003 has been entered.
2. Claims 23-37 have been added. Claims 1, 3-5, 7-9, and 11-37 are currently pending.

Election/Restrictions

3. As stated on page 2 of the Office action of August 27, 2002, in Paper No. 7, dated March 14, 2001, applicants elected without traverse of Group, claims 1-11, and the extraction procedure of claim 3 (extraction with a solvent having a polarity higher than 0.88). In response to the Office action of August 28, 2001, applicant effectively cancelled the elected species with the amendments to claim 1. Thus, in accordance with MPEP section 803.02, the new species selected for examination is the extraction procedure claimed in claim 1.
4. Claims 3-5, 7-9, and 12-37 are withdrawn from consideration as being drawn to non-elected invention and species.
5. Claims 1 and 11 are examined on the merits.

Claim Objections

Claim 1 is objected to because of the following informalities: in line 6 "consisting" should be "consists" and in line 7 "trough" should be "through." Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,317,816.

Applicant's claims are directed towards a composition containing an American ginseng extract which consists essentially of components with a molecular weight greater than 1,000.

US '816 teaches a saponin extracted from American ginseng. The extract is made by extracting the plant in various solvents, filtering, and drying (see claim 2; column 41-49; and column 5, lines 30-55). The saponin is at least one ginsenoside from a variety of disclosed ginsenosides (see column 3, lines 4-6). Of the ginsenosides disclosed, ginsenoside Rb1, Rb2, Rc, and Rb3 all have a molecular weight of greater than 1000 (see column 4, lines 1-14). Therefore, the reference teaches a composition that contains an extract from American ginseng that can only have components with a molecular weight greater than 1000.

The reference does not specifically teach that an ultrafiltration membrane with a molecular weight cut-off of 1,000 is used; however, the ginsenosides extracted have a molecular weight greater than 1. Therefore, the composition extracted by the reference appears to be the same as the claimed composition. The reference does not teach that the ginsenosides treat ulcers;

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however, due to the fact that the composition of US '816 is the same as the claimed composition, the composition of US '816 would inherently have the same effects on the human body as the claimed composition.

7. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Derwent English abstract of JP 04316507 A for the reasons set forth on page 3 of the Office action of August 27, 2002.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the reference contains compounds that have a molecular between 1,000 and 10,000. Applicant bases this assertion on Yoshikawa et al. which teaches an American ginseng extract that has molecular weights between 1,000 and 10,000. However, Yoshikawa does not negate the teaching of the reference. The reference specifically states that American ginseng extract is ultrafiltered to "give a component having a molecular weight of 10,000 daltons or over (third paragraph)." Thus, the reference teaches an American ginseng extract that contains a component over 10,000 and does not contain any components under this weight. These components would not be in the composition because they would have been removed during the ultrafiltration step. Therefore, the teaching of Yoshikawa does not seem relevant to the rejection based on the clear teaching by the reference of an extract that does not contain components of a molecular weight of less than 10,000.

8. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by English abstract of JP 61109732 A for the reasons set forth on pages 3 and 4 of the Office action of August 27, 2002.

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All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant traverses this rejection for the same reasons stated for the rejection based on JP '507. However, this reference is considered to anticipate the claims because the reference teaches isolating a specific polysaccharide that has a molecular weight of 100,000. Since this is an isolated component, other components with different molecular weights have been excluded. Therefore, the reference is considered to teach a composition extracted from American ginseng that does not contain components of a molecular weight of less than 1,000.

9. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner
May 1, 2003



LEON B. TANKFORD, JR.
PRIMARY EXAMINER